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In re Application of:
OBERLI, STEPHANE et al
Serial No. 10/516,972
Filed: Jul. 14, 2005
Docket: BLAN-37253
Title: PIG FOR INSTALLING A CABLE IN
A CONDUIT

2/12/09
DECISION ON PETITION
UNDER 37 CFR § 1.181

This is a decision on the petition filed January 30, 2009 under 37 CFR 1.181 requesting withdrawal of the communication regarding non-compliant appeal brief issued on December 31, 2008.

The petition is **granted**.

In the petition, petitioner argues that the examiner's communication mailed on December 31, 2008 requiring the applicant to file a corrected appeal brief in compliance with 37 C.F.R. 41.37(c)(1)(v) is in error. In particular, the examiner found the brief filed on November 26, 2008 does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters; and/or does not identify the structure, material, or acts described in the specification as corresponding to each claimed function for every means plus function and step plus function for each independent claim involved in the appeal and for each dependent claim argued separately by reference to the specification by page and line number, and to the drawing, if any, by reference characters, as required by 37 CFR 41.37(c)(1)(v). In particular, the examiner in essence stated that "a radially resilient support part" is not supported by the description on page 8, line 30 thru page 9, line 5 as indicated by the appellant. Therefore, this appeal cannot go forward due to this fatal defect.

In the petition, petitioner is of the opinion that the brief in its present form should have been admitted. In particular, petitioner argues that the examiner's objection to the brief is essentially the same issue as the 35 USC 112, first paragraph issue on appeal. The issue of new matter under appeal should be fairly decided by the Board of Appeals.

In finding petitioner's points of argument persuasive and after consultation with an administrator at the Board of Appeals, (Ms. Krista Zele), the requested relief is granted. The issue of new

matter under appeal is the same issue as the formality objection raised by the examiner in the Notification of Non-compliant Appeal Brief of December 31, 2008 and therefore must be decided by the Board of Appeals.

The examiner's communication mailed on December 31, 2008 requiring the applicant to file a corrected appeal brief in compliance with 37 C.F.R. 41.37(c)(1)(v) is hereby withdrawn. The examiner is directed to enter the Appeal Brief filed on Jan. 30, 2009 and proceed with appeal conference and an examiner's answer as soon as possible.

The application is being forwarded to Supervisory Patent Examiner of Art Unit 3723 for further processing. Any inquiry regarding this decision should be directed to Henry C. Yuen, Special Programs Examiner at (571) 272-4856.

PETITION GRANTED.



Donald T. Hajec, Director
Technology Center 3700